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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/742,871	12/20/2000	Barbara Stachowski	STAC-00301	7498
James A. Gavney, Agent HAVERSTOCK & OWENS LLP 162 North Wolfe Road. Sunnyvale, CA 94086			EXAMINER DOAN, ROBYN KIEU	
			ART UNIT 3732	PAPER NUMBER
			MAIL DATE 06/25/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/742,871

Applicant(s)

STACHOWSKI, BARBARA

Examiner

Robyn Doan

Art Unit

3732

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 February 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 8-10, 12-23 and 26-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) 21-23, 27 and 29 is/are allowed.
- 6) ☒ Claim(s) 1-5, 8-10, 12-20, 26 and 28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Applicant's Amendment filed 2/19/2008 has been entered and carefully considered. The terminal disclaimer has been received and approved, therefore, the double patenting rejection has been withdrawn. Claims 1, 8, 9, 12-14, 29 have been amended. Claims 6, 7, 24, 25 and 30 have been canceled. Claims 21-23, 27 and 29 are allowable over prior of record. Limitations of amended claims 1 and 14 have not been found to be patentable over prior art of record, therefore, claims 1-5, 8-20, 26 and 28 are rejected under the same ground rejections as set forth in the office action mailed 8/17/2007.

Claims 1-5, 8-10, 12-20 and 26, 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chubb (U.S. Pat. # 5,921,252) in view of Marcotte.

With regard to claims 1-3, 12, 13, Chubb discloses a parting device (40, fig. 1) for tracing and separating hair including a tip portion (42) for tracing through the hair, the parting device having two handles (43, 44) attached to each other at a hinge end (41), the handles being flares at unattached ends (at 40a, b). Chubb fails to show a stencil with a styling edge that outlines a predetermined pattern and is configured to function as a guide. Marcotte discloses a stencil (20, fig. 2) comprising a continuous styling edge with a plurality of rounded scallops (60, 62) that outline a predetermined pattern and is configured to function as a guide (see fig. 7). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have any of these components available at the same time. In other words, the individual components of

applicant's kit are already available as prior art; merely combining the components under the rubric of a "kit" does not result in a novel invention, even taken as a whole. It is contemplated that the user or any other hair care professional can meet applicant's claimed invention by simply purchasing the Chubb and Marcotte components and placing these components in proximity to each other, so as to fall under the rubric of a kit. Here, the novelty of the invention must reside in its whole, i.e. the kit, being greater than the sum of its parts, since the parts or components of the invention are already known in the art. With regard to limitations "wherein tracing the stencil on an area ... parts the hair according to the predetermined pattern", such features are directed to the intended use of the device and the devices of Chubb and Marcotte are capable to perform such function. In regard to claims 4, 9, 10, it would have been obvious to one having an ordinary skill in the art at the time the invention was made to construct the material of the stencil, handles and tip portion being plastic, the handles and the tip portion being monolithic, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416. In regard to claim 5, it would have been obvious to one having an ordinary skill in the art at the time the invention was made to construct the stencil having a length between 5 to 30 cm, width of 2 to 10 cm and a thickness between .1 and 1cm, since such a modification would have involved a mere change in the size of the known component. A change in size is generally recognized as being within the level of ordinary skill in the art. In re Rose, 105 USPQ 237 (CCPA 1955). In regard to claims 8, 14-20, 26, 28, Chubb in view of

Marcotte fail to show the hinge being a pin, screw or leaf spring and a second hinge for adjoining the second handle near its distal end to the extended tip section. It would also have been obvious to one having an ordinary skill in the art at the time the invention was made to construct a second hinge in replacing with the ring (45) of Chubb, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8. And it would have an obvious matter of design choice to have the hinge being a pin, screw of leaf spring since such modification is well known in the art.

Claims 21-23, 27, 29 are allowable over prior art of record.

Response to Arguments

Applicant's arguments fail to clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. Further, they do not show how the amendments avoid such references or objections.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robyn Doan whose telephone number is (571) 272-4711. The examiner can normally be reached on Mon-Fri 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cris Rodriguez can be reached on (571) 272-4964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Robyn Doan/
Primary Examiner, Art Unit 3732